

Reissue Application No.: 10/655,549
Reply to Office Action of April 7, 2010

Art Unit: 3688

REMARKS / ARGUMENTS

Applicant thanks the Examiner for the careful examination of the present application. The following remarks and arguments are responsive to the Office Action mailed on April 7, 2010.

I. Status of the claims

Claims 1 - 17 and 99- 166 are pending in this application. Claim 1-17 and 99-166 stand rejected.

II. Requirement for Reissue Oath/Declaration under 35 U.S.C. § 251

The Examiner rejected the application under 35 U.S.C. § 251 for lacking a proper reissue oath or declaration. In response, it is noted, that to date, Mr. David W. Roth, one of the two named inventors on the instant application, could not be found after diligent effort. The Assignee will submit a petition under 37 C.F.R. § 1.47(a) for the non-signing inventor. The Examiner is respectfully requested to hold this matter in abeyance pending the disposition of the petition.

III. Rejection under 35 U.S.C. § 103(a) over Goldhaber et al.

The Examiner rejected claims 1, 4, 15, and 99-166 as being unpatentable over U.S. Patent No. 5,794,210 to *Goldhaber et al.* ("*Goldhaber*").

Goldhaber describes a system and method that compensates users for viewing advertisements on their computers. According to *Goldhaber's* invention, when a user logs on to his personal homepage, the user is shown a list of preselected advertisements that are targeted to the user's interest. *Goldhaber* Col. 7 lines 27-32. A virtual "price tag" is associated with each advertisement that indicates the amount the user will receive for viewing the advertisement. Each time the user selects an advertisement for further viewing, the user is compensated in the form of digital cash according to the "price tag" associated with the advertisement. The digital cash is credited to the user's account. *Goldhaber* Fig. 3, Col. 10, lines 39-66.

It is noted that according to *Goldhaber* the advertisements that are shown to a user are preselected for that user. In pertinence, *Goldhaber* states the following:

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Upon logging on to her customized home page, Cynthia would be presented with a list of ads that she may elect to view. The ads would be preselected for her on the basis of a personal profile questionnaire that she has completed plus automatic tracking of her previous Internet usage. For example, today's list might contain ads for medium-price hotels in Mazatlan (where Cynthia is planning a vacation), a do-it-yourself telescope kit (a possibility for her son's upcoming birthday), San Francisco Forty-Niner football tickets (she's a fan), new nonfat organic dessert items (she's on a diet), and heavy equipment for earth moving (she is part-owner of a construction company). (emphasis added.)

Goldhaber at Col. 7, lines 27-35. Thus the system in *Goldhaber* present users with preselected advertisements together with associated price tags. The user then selects among the advertisements for further viewing, and is compensated according to the associated price tags.

The Examiner, in rejecting the claims, cites *Goldhaber* at col. 4 lines 52-54 wherein *Goldhaber* describes an auction mechanism through which advertisers can competitively bid for a viewer's attention. Yet, unlike the pending claims, *Goldhaber* fails to disclose a real-time bidding and selecting mechanism, whereby the winning bid is selected by the system in real-time – that is at the time the web page is requested by a user, prior to the web page being transmitted to the user.

For instance, claim 99 includes the following limitations: *receiving in the computer system an indication of the request for content... and in response to the request for content: submitting in the computer system one or more bids...* In other words, the bidding process occurs in response to the request for content – that is after the advertising opportunity has arisen. Nothing in *Goldhaber*, on the other hand, teaches or suggests that a bidding process occurs in real time. To the contrary, *Goldhaber* teaches that the advertisements are preselected, which necessarily means that any bidding mechanism cannot occur in real time.

The Examiner cites *Goldhaber* at col. 4, line 58-60, where it is stated that the “bidding may be explicit or automatic”. According to the Examiner, the reference to “automatic” implies a real-time bidding mechanism. Applicant respectfully disagrees. It is entirely unclear how automation in bidding would automatically result in real-time bidding as required by claim 99. Accordingly, Applicant respectfully traverses the rejection at least for the foregoing reasons.

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CONCLUSION

In view of the foregoing arguments and remarks reconsideration of the outstanding rejections is respectfully requested. Should the Examiner consider an interview helpful in advancing the present application, the Examiner is respectfully requested to contact the undersigned at the number indicated below.

Dated: April 7, 2011

Respectfully submitted,

/Benzion A. Wachsman/

Benzion A. Wachsman
General Manager
BEH Investments LLC (Assignee)
Tel.: (718) 928-2213
Fax: (718) 504-9671